UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,457	11/29/2000	Meir Shinitzky	24390	6935

20529 7590 03/27/2002

NATH & ASSOCIATES
1030 15th STREET
6TH FLOOR
WASHINGTON, DC 20005

EXAMINER	
TURNER, SHARON L	

ART UNIT	PAPER NUMBER
1647	9

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/647,457	Schintzky et al.
Examiner	**Art Unit**
Sharon L. Turner, Ph.D.	1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 7-10-01

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-8 and 10-14 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 1-8 and 10-14 are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Improper Markush

1. Prior to setting forth the restriction requirement, it is pointed out that applicants have presented instant claims in improper Markush format, see Ex parte Markush, 1925 C.D. 126, In re Weber, 198 USPQ 334 and MPEP 803.02 and 806.04.

> "Since the decisions in In re Weber **,198 USPQ 328 (CCPA 1978); and In re Haas, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention, In re Harnish , 631 F.2d 716, 206 USPQ 300 (CCPA 1980); Ex Parte Hozumi , 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility."

The claims are improperly set forth as the genus claims encompassing multiple distinct peptides fail to share the characteristics of a genus, i.e., a common utility and a substantial structural feature essential to the disclosed utility. Alternatively, the claims define multiple structurally distinct compounds capable of different use, with different modes of operation, different function and different effects. A reference against one of the claimed components or methods would not be a reference against the other. Therefore, the restriction will be set forth for each of the various groups, irrespective of the improper format of the claims, because the claims define inventions which are not proper species.

Election/Restriction

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, 8, 10-11 and 13-14 in part, drawn to the first special technical feature peptide of SEQ ID NO:2, kit and first appearing method of use in a diagnostic assay.

Group II, claim(s) 1, 3-6, 8, 10-11 and 13-14 in part, drawn to the technical feature peptide of SEQ ID NO:1, kit and method of use in a diagnostic assay.

Group II, claim(s) 1, 3-6, 8, 10-11 and 13-14 in part, drawn to the technical feature peptide of SEQ ID NO:3, kit and method of use in a diagnostic assay.

Group IV, claim(s) 1, 3-6, 8, 10-11 and 13-14 in part, drawn to the technical feature peptide of SEQ ID NO:4, kit and method of use in a diagnostic assay.

Group V, claim(s) 1, 3-6, 8, 10-11 and 13-14 in part, drawn to the technical feature peptide of SEQ ID NO:5, kit and method of use in a diagnostic assay.

Group VI, claim(s) 1, 3-6, 8, 10-11 and 13-14 in part, drawn to the technical feature peptide of SEQ ID NO:6, kit and method of use in a diagnostic assay.

Group VII claim(s) 1, 3-6, 8, 10-11 and 13-14 in part, drawn to the technical feature peptide of SEQ ID NO:7, kit and method of use in a diagnostic assay.

Group VIII, claim(s) 1, 3-6, 8, 10-11 and 13-14 in part, drawn to the technical feature peptide of SEQ ID NO:8, kit and method of use in a diagnostic assay.

Group IX, claim(s) 1, 4 and 14 in part, drawn to the technical feature peptide of claim 1 which binds to antibodies which do not bind SEQ ID NO:9.

Group X, claim(s) 1, 4 and 14 in part, drawn to the technical feature peptide of claim 1 which binds to antibodies which do not bind SEQ ID NO:10.

Group XI, claim(s) 1, 4 and 14 in part, drawn to the technical feature peptide of claim 1 which binds to antibodies which do not bind SEQ ID NO:11.

Group XII, claim(s) 1, 4 and 14 in part, drawn to the technical feature peptide of claim 1 which binds to antibodies which do not bind SEQ ID NO:12.

Group XIII, claim(s) 1, 4 and 14 in part, drawn to the technical feature peptide of claim 1 which binds to antibodies which do not bind SEQ ID NO:13.

Group XIV, claim(s) 1, 4 and 14 in part, drawn to the technical feature peptide of claim 1 which binds to antibodies which do not bind SEQ ID NO:14.

Group XV, claim(s) 1, 7-8, and 12-14 in part, drawn to the technical feature peptide of claim 7, kit and method of use in a diagnostic assay.

3. The inventions listed as Groups I-XV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The peptides each differ in sequence structure, length, function, effects and different utilities. The methods use different steps and different reagents corresponding to the distinct technical features peptides, exhibit different effects, functions and outcomes.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Turner, Ph.D. whose telephone number is (703) 308-0056. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.

Sharon L. Turner, Ph.D.
March 25, 2002

GARY L. KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600